

REMARKS/ARGUMENTS

In the Office Action mailed August 22, 2008 (hereinafter, “Office Action”), claims 1-15 were rejected under 35 U.S.C. § 112, first paragraph. Claims 1-15 were also rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 8, 13 and 15 are being amended. Applicants respectfully respond to the Office Action.

I. Claims 1-15 Rejected Under 35 U.S.C § 112, First Paragraph (Written Description)

Claims 1-15 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Independent claims 1, 8, 13 and 15 each previously recited “wherein the adapter is a handheld device that comprises a single board.” In the Office Action, the Examiner stated that “[e]ach of FIG. 9, FIG. 10 and FIG. 12 shows two boards: a single board computer 130 and data transceiver board 132 and the specification also discloses ‘the two boards are connected together by connecting wiring 134 (page 10, line 24) – hence an adapter that comprises two boards, not one board as claimed.’” (Office Action, page 2.)

Applicants have amended independent claims 1, 8, 13 and 15 to clarify that the “adapter … comprises a single-board computer.” This claim amendment is fully supported by Applicants’ specification, which states that “[t]he handheld adapter 126 includes a single-board computer 130.” (Applicants’ specification, page 10, lines 19-20.) Accordingly, Applicants respectfully submit that claims 1-15 fully comply with 35 U.S.C § 112, first paragraph.

II. Claims 1-15 Rejected Under 35 U.S.C § 112, First Paragraph (Enablement)

Claims 1-15 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In support of this rejection, the Examiner states: “See the written description rejection above.” (Office Action, page 2.) Thus, it appears that the basis for this rejection is the same as the basis for the written description rejection. As indicated above, independent claims 1, 8, 13 and 15 have been amended to clarify that the “adapter … comprises a single-board computer.” This claimed subject matter is fully enabled by Applicants’ specification.

(*See, e.g.*, page 10, lines 17-32 of Applicants' specification and Figures 9-12 of Applicants' drawings.) Accordingly, Applicants respectfully submit that claims 1-15 fully comply with 35 U.S.C. § 112, first paragraph.

III. Claims 1-15 Rejected Under 35 U.S.C. § 103(a)

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,623,604 to Russell et al. (hereinafter, "Russell") in view of U.S. Patent No. 6,708,045 to Lieu et al. (hereinafter, "Lieu"). Applicants respectfully request reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at ***4-5 (2007) (*citing Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a claim." In re Wada and Murphy, Appeal 2007-3733 (*citing CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Claim 1 has been amended to recite that the memory is programmed to cause the adapter "to send information to the provider computer that facilitates identification of appropriate device instructions for communicating with the electronic device." This amendment is supported by at least page 7, lines 14-17 and page 8, lines 22-27 of Applicants' specification.

The subject matter that has been added to claim 1 is advantageous because the adapter may be capable of being used in connection with different types of electronic devices. Sending "information ... that facilitates identification of appropriate device instructions," as claimed, allows the provider computer to send the appropriate device instructions to the adapter, i.e., device instructions that allow the adapter to communicate with the electronic device to which it is currently connected.

Russell describes a "Network Expansion Board ('NEB') 2 coupled to a printer 4.... The

NEB 2 is coupled to the LAN bus 6 through a LAN interface 8.... Also coupled to the LAN 6 may be ... PC 14...." (Russell, col. 4, lines 39-47.) The Examiner asserts that the NEB 2 in Russell is the "communications adapter" recited in claim 1, that the printer 4 is the "electronic device" recited in claim 1, and that the PC 14 in Russell is the "provider computer" recited in claim 1. (*See* Office Action, page 3.)

Even assuming for the sake of argument that these assertions are correct, Russell still does not teach or suggest all of the subject matter of amended claim 1. In particular, Russell does not teach or suggest that the NEB 2 sends information to the PC 14 that "facilitates identification of appropriate device instructions for communicating with" the printer 4, as required by amended claim 1. Russell does refer to "a transfer of data into the NEB for updating the ROM or RAM applications." (Russell, col. 21, lines 12-13.) Russell states that "anything from patch code, to manufacturing test routines, to firmware updates for the EPROM may be downloaded" to the NEB 2. (*Id.*, col. 21, lines 20-22.) However, at no point does Russell teach or suggest that the type of data that is downloaded to the NEB 2 is at all dependent on information received from the NEB 2. Unlike the "communications adapter" recited in claim 1, there is no suggestion in Russell that the NEB 2 can be used with different types of electronic devices.

Lieu does not teach or suggest a "communications adapter," as recited in claim 1. Lieu describes a computer 201, but the computer 201 in Lieu does not satisfy the requirement in claim 1 that the "communications adapter ... comprises a single-board computer." Because Lieu does not teach or suggest a "communications adapter" within the meaning of claim 1, it logically follows that Lieu also does not teach or suggest that the "communications adapter" includes "memory programmed to cause the adapter to send information to the provider computer that facilitates identification of appropriate device instructions for communicating with the electronic device," as recited in claim 1.

Thus, both Russell and Lieu fail to teach or suggest a "communications adapter ... send[ing] information to the provider computer that facilitates identification of appropriate device instructions for communicating with the electronic device," as recited in claim 1.

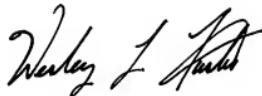
Appl. No. 10/784,485
Amtd. dated November 20, 2008
Reply to Office Action of August 22, 2008

For at least the foregoing reasons, Applicants respectfully submit that claim 1 is allowable. Claims 2-7 depend from claim 1. Claims 8, 13 and 15 have been amended to include subject matter similar to the subject matter argued above in relation to claim 1. Claims 9-12 depend from claim 8, and claim 14 depends from claim 13. Accordingly, Applicants respectfully submit that claims 2-15 are allowable for at least the same reasons as presented above in connection with claim 1.

IV. Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



/Wesley L. Austin/

Wesley L. Austin
Reg. No. 42,273
Attorney for Applicant(s)

Date: November 20, 2008

MADSON & AUSTIN
15 West South Temple, Suite 900
Salt Lake City, Utah 84101
Telephone: (801) 537-1700